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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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*Ex parte* PER SJORUP SIMONSEN

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Appeal 2008-0469
Application 10/512,097
Technology Center 1600

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Decided: April 21, 2008

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Before DONALD E. ADAMS, ERIC GRIMES, and FRANCISCO C. PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a method for producing gelatin. The Examiner has rejected the claims as anticipated, obvious, and having new matter. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the anticipation and obviousness rejections, but reverse the new matter rejection.[1]

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[1] In this decision we consider only those arguments actually made by Appellant. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

## STATEMENT OF THE CASE

"Conventionally gelatin is prepared from rind, usually from swine, by first chopping the rind with the accompanying fat layer into pieces . . ., hydrolysing the chopped rind with acid . . ., neutralising and extracting with water, first at 50°C and thereafter at successively rising temperature, the best gelatin quality, high Bloom, being obtained at 50°C" (Spec. 1).

The Specification discloses that "a better product and a higher yield is obtained when the rind is defatted before it is hydrolysed" (*id.*). Specifically, "the yield of high Bloom gelatin is typically 50% to 60% of the gelatin present in the rind, i.e. about 50% higher than by using the conventional method, and the produced gelatin has a higher strength than the gelatin produced by the conventional method" (*id.*).

Claims 1-6 are pending and on appeal (Br. 1), and read as follows:

1. A method for producing gelatin, said method comprising:
chopping or cutting a rind;
defatting the rind using steam and/or hot water;
hydrolyzing the defatted rind using an acid;
neutralizing the hydrolyzed rind material; and
extracting the neutralized rind material with water to form gelatin.

2. The method of claim 1, wherein said defatting the rind is carried out in a continuous process.

3. The method of claim 1, wherein said defatting the rind comprises defatting the rind to a fat content of 2% to 3%.

4. The method claim 1, wherein said chopping or cutting the rind comprises comminuting the rind into pieces of 5 mm or less before the hydrolysis.

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*See* 37 C.F.R. § 41.37(c)(1)(vii).

5. Gelatin produced by the method of claim 1.

6. The method of claim 1, wherein said cutting or chopping comprises cutting or chopping a rind into pieces not less than 1 mm.

The Examiner applies the following documents in rejecting the claims:

Lilja WO 94/21739 A1 Sep. 29, 1994

E. Haack et al., *Mechanical Deboning of Poultry and Fish and Defatting of Rinds Using the SFW 160 Separator (II)*, 38 Fleisch 58-60 (1984) (as translated).

The following rejections are before us for review:

Claim 5 stands rejected under 35 U.S.C. § 102(b) as anticipated by Lilja (Ans. 4).

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Lilja and Haack (Ans. 5-6).

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being obvious in view of Lilja and Haack (Ans. 6-8).

Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because it contains new matter (Ans. 6).

ANTICIPATION

*ISSUE*

The Examiner states that Lilja discloses "a gelatin product which, after testing, has a bloom number of 300 and 73% yield upon ultrafiltration, (see Table, page 15). This clearly anticipates claim 5" (Ans. 4).

Appellant contends that claim 5 "is directed to the product of the method of claim 1, which Lilja fails to teach or suggest" (App. Br. 6).

The issue with respect to this rejection, therefore, is whether the Examiner erred in finding that Lilja anticipates claim 5.

*FINDINGS OF FACT*

1. Claim 5 recites "[g]elatin produced by the method of claim 1."

2. Claim 1 recites a process of producing gelatin from rind. The process includes the steps of chopping or cutting the rind, defatting the rind using steam and/or hot water, hydrolyzing the defatted rind using an acid, neutralizing the hydrolyzed rind material, and extracting the neutralized rind material with water.

3. The Specification discloses that gelatin resulting from the conventional process has a Bloom strength of 280 (Spec. 1, ll. 9-15)

4. The Specification characterizes the gelatin produced according to claim 1 as having "a higher strength than the gelatin produced by the conventional method" (Spec. 1, ll. 21-22).

5. Lilja discloses gelatin having a Bloom number of 300, made by a process that had a 73% yield (Lilja 15 (Table, entry entitled "Without enzyme + UF")). The gelatin was made from bone meal particles that had been demineralized with phosphoric acid at pH 3, then extracted at pH 3.5 and 90°C, then neutralized, filtered on cellulose, and ultrafiltered (Lilja 14).

*PRINCIPLES OF LAW*

It is well settled that "[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

It is also "well settled that the presence of process limitations in product claims, which product does not otherwise patentably distinguish over the prior art, cannot impart patentability to that product." *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1318 (Fed. Cir. 2006) (quoting *In re Stephens*, 345 F.2d 1020, 1023 (CCPA 1965)). As stated in *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (citations omitted):

> [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Also, once the Examiner establishes that a product recited in terms of its process of making is prima facie unpatentable due to anticipation, Appellant bears the burden of proving "that the prior art products do not necessarily or inherently possess the characteristics of his claimed product." *Id.* at 698 (quoting *In re Fitzgerald,* 619 F.2d 67, 70 (CCPA 1980)); *see also In re Best,* 562 F.2d 1252, 1255 (CCPA 1977).

*ANALYSIS*

Because the Examiner has made out a prima facie case of anticipation which Appellant has not adequately rebutted, we affirm the Examiner's rejection of claim 5 as anticipated by Lilja.

Lilja discloses the same substance, gelatin, as that recited in claim 5. Moreover, Lilja's gelatin has a Bloom strength of 300 (*see* Finding of Fact ("FF") 5, above), significantly greater than the Bloom strength (280) of gelatin made by the conventional method which lacks a defatting step (*see* FF 3 and 4).

Thus, because Lilja discloses the same substance as claimed, and because that substance has a physical property disclosed by the Specification as resulting from the claimed process -- a Bloom strength significantly higher than 280 -- we agree with the Examiner that it was reasonable to conclude that Lilja's gelatin is the same as that recited in claim 5.

The fact that Lilja's gelatin was not made by the same process as claimed does not render it any less anticipatory. *See In re Thorpe*, 777 F.2d at 697. Moreover, because Appellant has not provided any evidence showing any difference between the claimed product and the prior art product, Appellant has not met the burden required to rebut the Examiner's prima facie case of anticipation. *See Thorpe*, 777 F.2d at 698. We therefore affirm the Examiner's rejection of claim 5 as anticipated by Lilja.

OBVIOUSNESS

*ISSUE*

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Lilja and Haack (Ans. 5-6). The Examiner has also entered a separate obviousness rejection of claim 6 over Lilja and Haack (Ans. 6-8).

With respect to claims 1-5, the Examiner cites Lilja as disclosing a process for making gelatin from collagen-containing raw materials including rind (Ans. 5). The Examiner finds that Lilja's process has the steps of grinding the raw material to particles not exceeding 1 mm, forming an

aqueous slurry containing the particles, raising the temperature of the slurry to 60-130°C and adjusting the pH to 2-5, readjusting the temperature and pH after the high temperature/low pH treatment, and recovering the gelatin by filtration and/or other cleaning steps (*id.*).

The Examiner cites Haack as disclosing "that defatted pork rind granules are useful in the manufacture of gelatin," and that its method "includes defatting the rind before acid hydrolysis for manufacture of the gelatin product" (*id.*). The Examiner concludes that one of ordinary skill would have considered it obvious "to follow the method for producing gelatin by Lilja et al. with the defatting of pork rind teachings of Haack et al. with the expectation of enhancing the production yield of gelatin" (*id.* at 5-6).

With respect to claim 6, the Examiner urges that one of ordinary skill would have considered it obvious "to cut rind into a size not exceeding 1 mm or into whatever size pieces necessary in order to carry out the method for producing gelatin taught by Lilja et al." (*id.* at 7-8).

Appellant contends that Lilja and Haack do not render claims 1-5 obvious because "the combined teachings would lead one of ordinary skill in the art to use mechanical defatting, not hot water or steam and, therefore, the combined teachings of Lilja and Haack fail to teach or suggest the claimed defatting of a rind using steam or hot water" (Br. 6). Appellant further contends that "the present use of steam or hot water to defat results in a superior yield" compared to Haack's process, and also produces "a better quality gelatin product" (*id.* at 7). With respect to claim 6, Appellant contends that "Lilja actually teaches away from the claimed not less than 1

mm pieces, as Lilja clearly discloses cutting the collagen-containing material to less than 1 mm and, preferably, to a size of 0.3 mm" (*id.* at 9).

The issue with respect to this rejection, therefore, is whether the Examiner erred in concluding that one of ordinary skill would have considered claims 1-6 obvious in view of Lilja and Haack.

*FINDINGS OF FACT*

6. Claim 1 recites a process of producing gelatin from rind. The process includes the steps of chopping or cutting the rind, defatting the rind using steam and/or hot water, hydrolyzing the defatted rind using an acid, neutralizing the hydrolyzed rind material, and extracting the neutralized rind material with water.

7. Lilja discloses "a method for producing gelatin from a collagen-containing raw material" (Lilja 5, ll. 9-10). Lilja discloses that the "method can be applied to different collagen-containing materials, such as hides, split, rind . . ." (*id.* at 5, ll. 28-30). Lilja discloses that "[o]ptionally, the material may be defatted prior to grinding, e.g. to a fat content not exceeding 3% by weight. Although such a step is not critical, a low fat content facilitates subsequent process steps" (*id.* at 7, ll. 9-12).

8. Lilja states that its process has the following steps:

> a) grinding the raw material to a particle size not exceeding 1 mm,
>
> b) mixing the ground raw material with water to form a slurry,
>
> c) subjecting the slurry from step b), in optional order, to an adjustment of the pH to 2-5 and to an adjustment of the temperature to 60-130°C for a time of from 1 s to 1 h,
>
> d) adjusting the temperature of the slurry once more,
>
> e) separating the slurry into a gelatin-containing liquid portion and a solid residue,

> f) adjusting the pH of the slurry or the liquid portion before or after, respectively, the separation, and
>
> g) recovering the gelatin from the liquid portion in filtration steps and/or other cleaning steps, with essentially no removal of process water in steps a)-f).

(Lilja 5, ll. 11-27).

Lilja discloses that its method "can be implemented in continuous or semicontinuous fashion" (*id.* at 6, ll. 8-9).

9. Haack discloses a "unit comprising an FW 160 mincer and an SFW drum-type separator" (Haack, abstract). Haack discloses that the unit may be applied "to defatting of pork rinds (after heat treatment); throughput is 1200 kg/h (yield 60%). This process[] also yields a defatted rind granulate, which may be incorporated in meat products or used for gelatin manufacture" (*id.*).

10. Haack discloses that "[t]he separation unit SFW 160/FW 160 . . . consists of the FW 160 mincer for the coarse diminution of the skeletal parts and the SFW 160 separator, rigidly interlinked with the FW 160. The separation process, the isolation of the meat from the bones or from the fish bones or the isolation of the fat from the rinds, are performed mechanically in the SFW 160 separator" (Haack 1).

11. Figure 4 of Haack is a flowchart showing the sequence in a "[p]rocess model of rind defatting, using the SFW 160/FW 160 separation unit" (Haack 5). The sequence of steps leading from rinds to gelatin production is as follows:

> 1 Raw material rinds from the production stage, meat processing
> 2 Handling in the production stage meat processing
> 3 Thermal processing of rinds in the water bath

> 4 Blanched rinds
> 5 Cooling of the blanched rinds
> 6 Cooled rinds
> 7 Separation of the rinds from fat with the SFW 160/FW 160 separation unit
> 8 Rind granules
> . . .
> 14 Gelatin production

(Haack 5-6.)

12. The Specification discloses a process in which 6,660 kilograms of rind are chopped to 5 millimeter pieces and defatted to a 2% fat content using steam and water to yield 5,000 kilograms of defatted rind (Spec. 2). The rind is then hydrolyzed with 37% hydrochloric acid at pH 2 for 17 hours, adjusted to pH 4 and extracted with water at 50°C to give a 43% yield of the gelatin present in the rind, the gelatin having a Bloom strength of 335 g (*id.*).

*PRINCIPLES OF LAW*

> In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

*In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (citations omitted, bracketed material in original). Thus, as the Supreme Court recently pointed out, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

The Supreme Court also indicated, however, that it is obvious to apply known solutions to a problem recognized in the prior art:

> When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

*Id.* at 1742.

Emphasizing a flexible approach to the obviousness question, the Court advised that the analysis under 35 U.S.C. § 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 1741. The Court further advised that "[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton." *Id.* at 1742.

It is well settled that evidence of unexpected results may rebut an examiner's prima facie case of obviousness. *See In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *see also KSR*, 127 S. Ct. at 1740 ("The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams's design was not obvious to those skilled in the art.") (discussing *United States v. Adams*, 383 U.S. 39 (1966)).

However, "any superior property must be *unexpected* to be considered as evidence of non-obviousness." *Pfizer, Inc. v. Apotex, Inc.,* 480 F.3d 1348, 1371 (Fed. Cir. 2007). Moreover, "objective evidence of nonobviousness must be commensurate in scope with the claims." *In re*

*Kulling*, 897 F.2d 1147, 1149 (Fed. Cir. 1990) (quoting *In re Lindner,* 457 F.2d 506, 508 (CCPA 1972)).

*ANALYSIS*

We agree with the Examiner that the claimed process would have been prima facie obvious to a person of ordinary skill in the art viewing Lilja and Haack. A person of ordinary skill practicing Lilja's process of making gelatin would have recognized from Lilja that rind material defatted to 3% or less of fat would be a useful starting material for the process, because a low fat starting material makes the subsequent processing steps easier (*see* FF 7). One of ordinary skill would have recognized from Haack that a defatted rind granulate produced by mincing a hot water-treated rind was a suitable starting material for making gelatin (*see* FF 9-11).

Given Lilja's disclosure of the desirability of a defatted starting material, and Haack's disclosure of a defatted rind granulate useful for making gelatin, we agree with the Examiner that a person of ordinary skill would have been prompted to use hot water to produce a defatted rind granulate as disclosed by Haack, and then obtain gelatin from the resulting defatted granulate using Lilja's hydrolyzing, neutralizing, and extracting steps. We therefore agree with the Examiner that the process recited in claim 1 would have been obvious to a person of ordinary skill in the art.

Appellant argues that one of ordinary skill would not consider Lilja's 130°C treatment of a rind-containing water slurry to be a rind defatting step, and "[m]oreover, the combined teachings of Lilja and Haack would lead one of ordinary skill in the art to use mechanical defatting, not hot water or steam and, therefore, the combined teachings of Lilja and Haack fail to teach

or suggest the claimed defatting of a rind using steam or hot water" (Br. 6-7).

We are not persuaded by these arguments. Because claim 1 uses open "comprising" language to describe the process, claim 1's step of "defatting the rind using steam and/or hot water" encompasses defatting processes having steps in addition to using steam and/or hot water. *See Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps.").

Thus, because Haack uses hot water in its process of defatting rind (FF 11), Haack meets claim 1's requirement of "defatting the rind using steam and/or hot water," despite the fact that Haack uses mechanical means in addition to hot water to defat the rind. Moreover, the impetus for defatting the rind using steam and/or hot water according to Haack would have been Haack's disclosure that the resulting product is useful for making gelatin (FF 9-11). Combined with Lilja's disclosure that a defatted starting material makes the gelatin-producing process easier (FF 7), a person of ordinary skill would have been prompted to use hot water to produce a defatted rind granulate as disclosed by Haack, and then obtain gelatin from the resulting defatted granulate using Lilja's hydrolyzing, neutralizing, and extracting steps.

We note that Haack discloses using the FW 160 mincer after the hot water bath (*see* FF 11), whereas claim 1 lists the chopping step before the defatting step. However, unlike the remaining steps, claim 1 does not suggest that the rind must be chopped before it is treated with hot water. *See Interactive Gift Express, Inc. v. Compuserve Inc.*, 231 F.3d 859, 875

(Fed. Cir. 2000) ("Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one.").

Therefore, because one of ordinary skill producing defatted rind granules according to Haack would have been prompted to obtain gelatin from the defatted rind by Lilja's hydrolyzing, neutralizing, and extracting steps, we agree with the Examiner that a person of ordinary skill would have considered claim 1's process prima facie obvious.

Appellant argues that "the present use of steam or hot water to defat results in a superior yield" compared to Haack's process, which "results in a defatted rind of about 60%" (Br. 7).

We are not persuaded by this argument. It is well settled that "any superior property must be *unexpected* to be considered as evidence of non-obviousness." *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1371 (Fed. Cir. 2007). Appellant has not argued, nor do we see any evidence showing, that the yield of defatted rind shown in the Specification's example would have been unexpected in light of the yield disclosed by Haack.

Appellant argues that "the present method results in both a higher yield and a better quality gelatin product, thus further distinguishing the present method from that taught by Lilja" (Br. 7).

We do not find this argument persuasive. The Specification discloses that practicing the claimed invention can give a 43% yield of gelatin having a Bloom strength of 335 g (FF 3 (Spec. 2)). Lilja discloses obtaining a 73% yield of gelatin with Bloom number of 300 (FF 5 (Lilja 15)). Thus, Lilja discloses a significantly superior yield and comparable gelatin quality to that disclosed by Appellant.

Also, the process in Appellant's example uses a number of specific process parameters not recited in the claims, including a specific duration for the hydrolysis step, specific pH values for the hydrolysis and neutralizing steps, and a specific temperature for the extraction step (*see* FF 12). Because "objective evidence of nonobviousness must be commensurate in scope with the claims," *In re Kulling*, 897 F.2d 1147, 1149 (Fed. Cir. 1990), we do not agree with Appellant that the process exemplified in the Specification demonstrates that the claimed process is unobvious over Lilja.

Moreover, because Lilja discloses performing its process continuously (*see* FF 8), with a starting material defatted to not more than 3% (FF 7) and ground to a particle size "not exceeding 1 mm" (FF 8 (Lilja 5)), we do not agree with Appellant that claims 2-4 are distinguishable over Lilja. As discussed above, we also do not agree with Appellant that Lilja's gelatin is distinct from that recited in claim 5.

With respect to claim 6, as pointed out by the Examiner, the recitation "pieces not less than 1 mm" encompasses particles one millimeter in size. Lilja's disclosure of using a particle size "not exceeding 1 mm" (FF 8 (Lilja 5)) also encompasses particles one millimeter in size. Because Lilja's particle size range overlaps claim 6's size range, we agree with the Examiner that a person of ordinary skill would have considered claim 6 obvious in view of the cited references.

In sum, we agree with the Examiner that a person of ordinary skill in the art would have considered claims 1-6 prima facie obvious in view of Lilja and Haack. Because we do not agree with Appellant that the evidence of record is sufficient to rebut the Examiner's prima facie case of

obviousness, we affirm the Examiner's rejections of claims 1-6 over those references.

NEW MATTER

*ISSUE*

Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 6). The Examiner contends that claim 6 is "directed to the method of claim 1, wherein cutting or chopping comprises cutting or chopping a rind into pieces not less than 1 mm. However, cutting or chopping a rind into pieces not less than 1 mm is not disclosed in the specification, and is therefore new matter" (*id.*).

Appellant contends that "[t]he disclosed examples of 'approximately 5 mm' and 'e.g., 1 mm' support[] the claimed cutting or chopping a rind into pieces not less than 1 mm. Clearly, disclosing cutting to 1 mm or approximately 5 mm pieces discloses cutting into pieces which are not less than 1 mm" (Br. 8). Therefore, Appellant contends, "claim 6 does not present new matter and is in full compliance with the requirements of 35 U.S.C. § 112, first paragraph (written description)" (*id.*).

The issue with respect to this rejection, then, is whether the Examiner erred in finding that claim 6's recitation "cutting or chopping a rind into pieces not less than 1 mm" fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

*FINDINGS OF FACT*

13. Claim 6 recites "[t]he method of claim 1, wherein said cutting or chopping comprises cutting or chopping a rind into pieces not less than 1 mm."

14. The Specification discloses that "[i]f the rind is sufficiently comminuted, e.g. in pieces of 1 mm, the hydrolysis may also be carried out continuously" (Spec. 1, ll. 30-31). The Specification also discloses that "6,660 kg of rind, chopped into pieces of appr. 5 mm, are defatted with steam and hot water in a continuous process to a fat content of 2% and are carried to a 10 $m^3$ reactor" (*id.* at 2, ll. 21-23).

15. Claim 4 as originally filed recited "the rind is comminuted into pieces of 5 mm or less before the hydrolysis" (*see* "Claims" filed October 21, 2004).

*PRINCIPLES OF LAW*

As stated in *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001):

> The written description requirement and its corollary, the new matter prohibition of 35 U.S.C. § 132, both serve to ensure that the patent applicant was in full possession of the claimed subject matter on the application filing date. When the applicant adds a claim or otherwise amends his specification after the original filing date . . ., the new claims or other added material must find support in the original specification.

The test for determining whether a specification is sufficient to support a particular claim "is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.,* 772 F.2d 1570, 1575 (Fed.Cir.1985) (quoting *In re Kaslow,* 707 F.2d 1366, 1375 (Fed.Cir.1983)). Thus, "[i]t is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that

appellants invented processes including those limitations." *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citation omitted).

*ANALYSIS*

We agree that the Specification as filed reasonably conveys to a person of skill in the art that Appellant possessed the subject matter recited in claim 6. The Specification discloses comminuting rind to pieces of 1 millimeter and 5 millimeter in size (*see* FF 13), and originally filed claim 4 recites comminuting rind to pieces of 5 millimeters or less (FF 14).

Because these original disclosures convey that Appellant invented a process in which rind is chopped to 1 millimeter particles, as well particles larger than 1 millimeter, we agree that Appellant was in possession of a process in which the chopping or cutting produces pieces "not less than 1 mm," as recited in claim 6.

The Examiner argues that the recitation "not less than 1 mm" in claim 6 "means that no particles having a size smaller than 1 mm are permitted" (Ans. 12). However, the Examiner argues, "the example of 1 mm says nothing about precluding particles that are smaller than 1 mm since it is only an example of a suitable particle size. Thus, the specification as filed does not provide support for, 'not less than 1 mm'" (*id.*).

We are not persuaded by this argument. The issue with respect to the written description requirement is not whether the originally filed disclosure supports an amendment whose effect is to exclude certain subject matter from the claims. Rather, the issue is whether the application as filed reasonably conveys to one of ordinary skill that Appellant was in possession of the subject matter recited in the claim. *See Ralston Purina* and *Wertheim, supra*.

As discussed above, we agree that Appellant possessed the subject matter recited in claim 6. We therefore reverse the Examiner's new matter rejection of that claim.

SUMMARY

We affirm the Examiner's rejection of claim 5 under 35 U.S.C. § 102(b) as anticipated by Lilja.

We affirm the Examiner's rejection of claims 1-5 under 35 U.S.C. § 103(a) as obvious over Lilja and Haack, and also affirm the Examiner's separately presented obviousness rejection of claim 6 over those references.

We reverse the Examiner's new matter rejection of claim 6 under 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

dm

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